

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue application of : Jan Hendrik Mensen

Docket No.: J8500.3

Reissue Application No. : 09/374,598

Office of Petitions

Filed : August 13, 1999

Original Patent No. : 5,657,600

Issued: August 19, 1997

For : WEB MEMBER FOR CONCRETE FORM WALLS

**PETITION UNDER 37 CFR 1.183 TO WAIVE 37 CFR 1.172 TO ACCEPT THE
USPTO-REQUIRED SUPPLEMENTAL REISSUE DECLARATION IN THE
ABSENCE OF THE NAMED INVENTOR'S SIGNATURE**

Stop: Petitions
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition under 37 C.F.R. § 1.183 requesting that the USPTO waive the rules and accept the supplemental reissue declaration required by the examiner, and submitted herewith, notwithstanding the lack of execution by the named inventor.

As background, the sole named inventor, Jan Hendrik Mensen, (aka "Henk" Mensen) assigned his entire rights, title, and interest in the original patent to his then employer: AAB Building System Inc., ("AABS") as recorded by the USPTO on November 2, 1994, at reel 007185, frame 0569. (*Exhibit A*). AABS subsequently underwent a change of name and is

now known as ARXX Building Products, Inc. (“ARXX”) as recorded by the USPTO on July 23, 2001, at reel 012002, frame 0506. The assignment(s) of the original patent will be presumed to establish ownership of this reissue application. MPEP 1410.01, subsection II. Mr. Mensen is not now employed by ARXX. ARXX as the assignee of the entire interest of the sole named inventor is the true and entire party of interest in this matter.

Since this instant application is a broadening reissue, the statute and regulations require that the named inventor execute the original reissue declaration. 35 U.S.C. § 251; *compare* 37 CFR 1.175(b)(1) *with* 37 CFR 1.172 Mr. Mensen cooperated with ARXX and executed the original reissue declaration on December 23, 1999.

In due course, the examiner required in May 2007, a supplemental reissue declaration so as to fulfill the requirements of 37 CFR 1.175.

ARXX has since then diligently undertaken to obtain Mr. Mensen’s signature on the required supplemental declaration, even by offering a very generous consideration fee, but to no avail.

On May 30, 2007, promptly after being advised of the examiner’s requirement for a supplemental reissue declaration, counsel for ARXX Richard Meyer mailed, *inter alia*, a supplemental reissue declaration to Mr. Mensen along with a request that the declaration be signed and returned. See Letter of May 30, 2007 from counsel Richard Meyer to Mr. Mensen (*Exhibit B*); Letter of Frank O’Dea, ARXX President and CEO, dated December 12,

2007, (*Exhibit D*). As further indicated in the O'Dea letter, Mr. Mensen replied by electronic mail on July 26, 2007, and made what seemed to ARXX, an exorbitant and unreasonable demand for reimbursement to the amount of \$138,000 (CA) to review and sign the supplemental reissue declaration. See copy of e-mail from Mr. Mensen dated July 26, 2007 (*Exhibit C*).

In the O'Dea letter of December 12, 2007, ARXX nevertheless continued to try to negotiate with Mr. Mensen, and was willing to reasonably compensate Mr. Mensen to review and execute the papers.

Receipt by Mr. Mensen of the letter dated December 12, 2007 along with the Supplemental Declaration was confirmed on December 28, 2007 by the Canadian Postal Service (*Exhibit E*).

On February 8, 2008, Mr. Mensen replied to the O'Dea letter and indicated his willingness to meet with ARXX while he was traveling to Canada (*Exhibit F*).

As recounted in the March 20, 2008, memorialization of Scott Jaglowitz, (ARXX Vice President for Finance) (*Exhibit G*), Mr. Mensen and Mr. Jaglowitz met in Canada to discuss possible terms for Mr. Mensen's execution of the papers. According to Mr. Jaglowitz's concurrent memorialization of that meeting, it was established that Mr. Mensen had not incurred any expenses relating to the ARXX patent, and ARXX offered some \$15,000 (CA) to Mr. Mensen for his time and trip to Canada. Mr. Mensen, however, refused,

and again demanded an amount of at least \$100,000 (CA).

The foregoing establishes that AARX has acted diligently and in good faith in this matter. Mr. Mensen long ago assigned all his rights in the patent to ARXX, is not employed by ARXX, and has no further interest in this matter, other than his attempt to turn the USPTO requirement for a supplemental reissue declaration into a windfall. ARXX has offered a more than reasonable compensation to Mr. Mensen in a good faith effort to obtain his signature on the supplemental declaration. It follows that the failure to obtain Mr. Mensen's signature on the required supplemental reissue declaration is due to circumstances beyond the control of ARXX and its representatives.

The USPTO has indicated that it is willing to consider petitions for waiver of an inventor's signature in a broadening reissue application where a named inventor refuses to execute a supplemental reissue declaration. See MPEP 1414.01, subsection III. It is respectfully submitted that (1) Mr. Mensen's refusal to accept ARXX's reasonable offer(s) of reimbursement (up to \$15,000 (CA)) and (2) Mr. Mensen's initial and continued demands over an extended period for an unrealistic and unwarranted amount of compensation for his signature, are tantamount to a refusal by Mr. Mensen to execute the proffered reissue declaration.

Clearly, this is an extraordinary circumstance where justice requires, and would best be served by, waiver of the rules where they require Mr. Mensen to execute the required

supplemental reissue declaration.

The Commissioner is hereby authorized to charge the \$400 petition fee required by 37 CFR 1.17(f), and any additional fees, or credit any overpayment to Deposit Account No. 50-2929.

Should the Petitions Examiner have any questions, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,
ARXX as successor to Jan Henrick Mensen

A handwritten signature in black ink, appearing to read 'Abraham HersHKovitz', written over a horizontal line.

Abraham HersHKovitz
Reg. No. 45,294

Enclosures: Supplemental Declaration
Exhibits A-G

April 22, 2008
HERSHKOVITZ & ASSOCIATES
2845 DUKE STREET
ALEXANDRIA, VA 22314

703-370-4800 (voice)
703-370-4809 (fax)

patent@hershkovitz.net